

REMARKS

35 U.S.C. § 102 rejection of claims 37–39, 41–44, 46 and 48 – 52

In the final rejection mailed 19 September 2007, the examiner argued that Ding discloses a method of curing a composition onto a device wherein the solvent is evaporated by heating the coated device from about 90 °C to about 150 °C "depending on the polymer, drug and solvents used."

The examiner also states that Ding teaches that the device that is to be coated can be a self- or balloon- expandable stent that can be made of polymeric, ceramic, metallic or composite materials. Finally the examiner points to disclosures of polymers that can be used to coat and drugs that can be loaded onto the devices.

The examiner also addressed applicants' arguments set forth in the 2 July response to the office action mailed on 30 March 2007. The examiner states that he disagrees with applicants' assertion that Ding does not teach that the temperature is greater than about the glass transition temperature but below the melting point of the polymer. The examiner states that

the limitation of the temperature is met by some of the polymers listed [in Ding], for example, polyvinyl chloride has a glass transition temperature of 87 °C and a melting point temperature of 212 °C; polystyrene has a glass transition temperature of 95 °C and a melting point temperature f 240 °C. As can be seen from these two examples, the temperature of Ding is above the glass transition temperature and below the melting point temperature.

Applicant's traverse.

Applicants' response

Everything the examiner notes that Ding discloses is accurate. That which Ding does not disclose, however, is much more to the point. That is, the sum total of Ding's disclosure regarding temperature is the following:

More typically, the curing/evaporation process involves higher temperatures so that the coated device is heated in an oven. Typically, the heating occurs at approximately 90 °C or higher for approximately 1 to 16 hours. For certain coatings the heating may occur at temperatures as high as 150 °C. The time and temperature of heating will of course vary with the particular polymer, drugs, and solvents used.

One of skill in the art is aware of the necessary adjustments to these parameters. Col. 5, lines 12-19.

Ding never once mentions glass transition temperatures or crystalline melting temperatures and certainly does not even hint that these temperatures should in any way bear on the curing/evaporation temperature selected. The useful polymers listed by Ding include many which are known to those skilled in the art to be amorphous (for example, without limitation, many silicones (Col. 4, line 6) and many acrylic polymers (Col. 4, line 8) such as, to note but one, poly(methyl methacrylate)). Such polymers do not even have a crystalline melting temperature. Numerous others in the list, such as for instance, again without limitation, some polyolefins (Col. 4, line 7) such as polyethylene have melting points below 150 °C. Yet Ding discloses simply a polymer-independent range of about 90 °C to about 150 °C without any enunciated concern about these parameters. Clearly Ding does not come close to expressly disclosing each and every element of independent claims 37 and 46.

While not expressly stating such, it may be the examiner's position that Ding inherently discloses the heating temperature of the current invention. Such could not be further from fact, as evidenced by the examiner's own words: "...the limitation of the temperature is met by **some** of the polymers ..." It is well-established law that anticipation by inherency requires that a cited reference anticipate without disclosing a feature of the claimed invention if that characteristic is necessarily present, or inherent, in the single anticipating reference. The Toro Company v. Deere & Company, 355 F.3d 1313 (Fed. Cir. 2004). It is equally well-established, however, that:

inherency may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.

SmithKline Beecham Corp. v. Apotex Corp., 403 F.3d 1331 (Fed. Cir. 2005).

The fact that some of the polymers listed in Ding happen to fall within the temperature ranges set by the current invention is as clear an example of a "thing can may result from a given set of circumstances," i.e., picking the right polymer, as can be imagined. Ding, therefore, does not anticipate the current invention by inherency.

Since Ding does not anticipate independent claims 37 and 46, it necessarily follows that it cannot anticipate any of claims 38, 39, 41 – 44, or 48 – 52, which depend

from claims 37 and 46 and, therefore, must incorporate all the limitations of those independent claims.

35 U.S.C. § 103 rejection of claims 37 – 44, 46 and 48 - 52

The examiner argues that the current invention is obvious and therefore unpatentable over Ding. Applicants traverse.

Applicants' response

Simply put, while the fact that some of the polymers noted in Ding as being useful have both glass transition temperatures and melting temperatures would be known to those skilled in the art, there is certainly absolutely nothing in Ding, nor does the examiner expressly and specifically explicate anything in the general knowledge of those skilled in the art or, for that matter, "common sense" that would lead the skilled artisan to limit the solvent evaporation temperature of a coating to greater than the glass transition temperature and less than the melting temperature of the polymer used in the coating. The current invention is not the least bit obvious and therefore is patentable over Ding.

35 U.S.C. 112, second paragraph, rejection of claims 37 – 43, 46 and 48 – 52

The examiner rejected claims 37 – 43, 46 and 48 – 52 as being indefinite for failing to particularly point out and distinctly claim the subject matter that applicants' consider the invention. In particular, the examiner states that the phrase "greater than about," "above," or "about" with regard to temperatures are unclear.

Applicants' response

While applicants do not necessarily accede to this grounds for rejection, to facilitate the early passage of this application to issue, applicants have amended the claims in such a manner as to render this rejection moot.

CONCLUSION

Applicants believe that, based on the amendments to the claims and the remarks above, this application is in condition for allowance and respectfully request that it be passed to issue.

Applicant requests a three month extension in time to respond to the 19 September 2007 office action and authorizes the Commissioner to charge the fee due Deposit Account No. 07-1850.

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Respectfully submitted,

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